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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RAHMJOO, MANUCHER

ART UNIT PAPER NUMBER

2676

DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,972

Applicant(s)

BATTLES, AMY E.

Examiner

Mike Rahmjoo

Art Unit

2676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 3, which depends on claim 2, has the exact same wording as claim 2 and therefore it is not further limiting the invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21- 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 21 line 21 on page 6 recites "...interactively receive...". The term interactively is not mentioned in the specification. OK

Claim 28 has similar rejection.

Claims 22- 27 and 29- 31 are also rejected because they depend on rejected independent claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21- 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 21 line 22 on page 6 recites "...to other images...". It is not clear what these other image are and which images they refer to.

1) Claim 21 recites the limitation "ranked the displayed..." in line 21 of page 6. There is insufficient antecedent basis for this limitation in the claim. OK

2) Claim 28 recites the limitation "...the plurality of displayed images..." in line 20 of page 8. There is insufficient antecedent basis for this limitation in the claim. OK

3) Claim 28 recites the limitation "...the sized pictorial images..." in line 24 of page 8. There is insufficient antecedent basis for this limitation in the claim. OK

Claims 22- 27 and 29- 31 are indefinite because they depend on indefinite antecedent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 3, 5- 13, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolan (US Patent 5,754,873).

As per claims 1, 19 and 20 Nolan teaches displaying an image to the user; receiving information from the user for said image, said information comprising ranking information (display size); and sizing said image (text size) based on said ranking information see for example column 2 lines 25- 67 and column 3 lines 1- 25 and figures 2 and 3a- c.

As per claim 2 Nolan teaches generating an album page including said sized image see for example figures 2 and 3a- c.

As per claim 3 Nolan teaches printing said album page see for example figure 3a and column 7 lines 28- 31.

As per claim 5 Nolan teaches image is stored as image data, further comprising storing said ranking information in association with said image data see for example column 2 lines 25- 67 and column 3 lines 1- 25.

As per claim 6 Nolan teaches repeating said displaying and said receiving for a plurality of images, before said sizing see for example column 2 lines 25- 67 and column 7 lines 28- 41 and column 10 lines 46- 62.

As per claim 7 Nolan teaches said sizing comprises sizing to zero (deleting) all images associated with ranking information having a value less than a particular value see for example column 10 lines 15- 18.

As per claim 8 Nolan teaches generating an album page that excludes said images sized to zero see for example column 7 lines 28- 41.

As per claim 9 Nolan teaches said ranking information has one of a plurality of discrete values see for example column 2 lines 24- 43.

As per claim 10 Nolan teaches said sizing comprises selecting a discrete image size corresponding to said ranking information see for example column 2 lines 44- 60 and column 6 lines 59- 67 through column 7 lines 1- 8 and figures 2 and 3a- c.

As per claim 11 Nolan teaches said ranking information is received from a keyboard see for example figure 2 and column 5 lines 55- 65.

As per claim 12 Nolan teaches said ranking information is received from a mouse see for example figure 2 and column 60- 65.

As per claim 13 Nolan teaches said ranking information is received from a selection control see for example column 2 lines 24- 59 and column 5 lines 56- 65 and figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, and 14- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan (US Patent 5,754,873) in view of Anderson et al (US Patent 6,177,956), hereinafter, Anderson.

As per claims 4, and 14- 18 Nolan teaches displaying an image to the user, receiving information from the user for said image, said information comprising ranking information (display size), sizing said image (text size) based on said ranking information see for example column 2 lines 25- 67 and column 3 lines 1- 25 and figures 2, and 3a- c; storing said ranking information in association with same image, and printing said at least one album see for example column 7 lines 28- 41 and figure 3a- c.

Nolan does not teach said image is a photographic image and a camera processor.

However, Anderson teaches a photographic image and a camera processor see for example column 4 lines 8- 14 and figure 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anderson into Nolan to have an imaging device capturing an image in response to an image capture request to produce corresponding raw image data which is temporarily stored into a frame buffer which is later used by the data cell manager and thus make it a versatile and efficient piece of equipment see for example column 1 lines 45-57.

As per claim 16 Anderson teaches an enter control electrically connected to camera processor see for example figures 1- 3.

As per claim 17 Nolan teaches said at least one ranking control controls a cursor on said camera display see for example column 2 lines 44- 59.

As per claim 18 Nolan teaches said at least one ranking control controls highlighting of a ranking option on said camera display see for example figure 2 and column 8 lines 21- 56.

Response to Arguments

Applicant's arguments filed 01/07/2004 have been fully considered but they are not persuasive.

As per applicant's remarks, applicant argues on page 11 that the primary art made of the record does not teach "ranking information". As per argument made of the record dated 07/23/2003, the examiner made a citation of the dictionary meaning of "ranking information" which substantially covered the analogies of "cardinal vs. ordinal numbers". Column 2 lines 25- 67, column 3 lines 1- 25 and figures 2, 3 a- c thoroughly

teach "ranking information". The ranking information taught through Nolan is on relative terms and the hierarchy of information is clearly taught in the above citations and column 7 lines 1- 8 as well, which very much fall under the category of "ordinal numbers". The sizing of Nolan is relative to a given reference such as 12 points. Other sizes are given by the examples of the text sections (album page displayed in window 47 or on display 22 which can be printed see for example column 7 lines 28- 30) as first, second and third sizes namely 44, 46, and 48.

On page 11 line 10 applicant argues "...converting the ordinal ...". The conversion element is not included in the claim language. The examiner would suggest amending the claim such as to further include the limitation as per argument.

It is not clear how ranking can assume a discrete value due to the fact that discrete is referred to as "unconnected elements" according to Merriam- Webster's Collegiate Dictionary, 10th edition and "ranking", a connecting terminology, as previously cited is referred to as "relative standing or position and a grade of official standing in a hierarchy". Therefore, the plurality of discrete values according to the language of claim 14 would have to be related due to the existence of relativity in the hierarchy.

As per applicant's argument on page 12 of the remarks on "sizing to zero being an operation automatically performed by a processor" and the "deleting" taught by Nolan, the examiner would respond that the deletion process is also performed by a processor and due to the fact that the end results are the same, deletion fairly reads on applicant's claim language.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; US Pub 2002/0180803, 2001/0035875, US Patent 6,101,292.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Rahmjoo whose telephone number is (703) 305- 5658. The examiner can normally be reached on 6:30- 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (703) 308- 6829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872- 9314 for regular communications and (703) 872- 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305- 4750.

Mike Rahmjoo

January 16, 2004

A handwritten signature in black ink, appearing to be 'Kee M. Tung', with a long, sweeping horizontal stroke extending to the right.

Kee M. Tung
Primary Examiner